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VB

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/073,138	05/05/98	KAWAKAMI	Y 2026-4124US3

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EXAMINER

JOHNSON, N

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

10/22/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/073,138

Applicant(s)

Kawakami

Examiner

Nancy Johnson

Group Art Unit

1642



☒ Responsive to communication(s) filed on Aug 16, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 29-31 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 29-31 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

1. Claims 29-31 have been amended.

Claims 29-31 are pending.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

3. The rejection of claims 29-31 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention is maintained. The recitation "consisting essentially of" in amended claims 29-31 is vague and indefinite. "Consisting essentially of" language is appropriate for claims drawn to methods and compositions, as it closes the claim to the addition of any materials other than those recited, except for impurities. However, "consisting essentially of" language is not appropriate for claims drawn to chemical structures, such as amino acid sequences. The nature of substitutions to the recited chemical structure encompassed by the claim is unclear. In the instant application, if the claims 29-31 are not drawn to peptides consisting of 5-20 contiguous amino acids of SEQ ID NO:27, it is uncertain what types of modifications to these peptide sequences is encompassed by the claim, for example; conservative substitutions of amino acid residues, single amino acid deletions, the addition of one or many amino acid residues, the addition of residues other than amino acids? The applicant is advised to amend the claim to recite "consisting of" and for examination purposes, the recitation "consisting essentially" will be interpreted as open language, as "comprising."

4. The rejection of claims 29-31 under 35 U.S.C. 102(b) as being anticipated by WO 92/21767 is maintained. WO 92/21767 discloses pharmaceutical compositions of the N-terminal peptide of the AgME20 antigen and methods of immunization and treating melanoma with said peptide that are the same as that claimed (see claims 37-49). The peptide (SEQ ID NO:1) is 100% identical to amino acid residues 25-53 of the instant gp100 polypeptide, is thus a "peptide having (comprising) 5-20 contiguous amino acids of gp100," and is the same as that claimed.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nancy Johnson whose telephone number is (703) 305-5860. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Hutzell, can be reached on (703) 308-4310. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.



NANCY A. JOHNSON, PH.D
PRIMARY EXAMINER

October 20, 1999